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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,965	09/26/2003	Eurell Thomas Eubanks	80021	3602

7590 07/26/2005

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EXAMINER

CHAN, SING P

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/672,965

Applicant(s)

EUBANKS ET AL.

Examiner

Sing P. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-68,71 and 72 is/are pending in the application.
- 4a) Of the above claim(s) 22-46,51-68,71 and 72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21,47-50 and 70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/23/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of group I, claims 1-21, 7-50, and 71-72 in the reply filed on May 23, 2005 is acknowledged. The traversal is on the ground(s) that there is not a serious burden on the examiner to examine all the claims. This is not found persuasive because the composition is in a different classification than the method and required a separate search due to the divergent subject matters.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-21, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson (U.S. 6,607,621) in view of Shih et al (U.S. 5,891,294).

Regarding claims 1 and 3-21, Swanson discloses a method of patching a wall. The method includes providing a dry film, removing the adhesive backing to expose the adhesive, applying the dry film over a hole portion of the wall, pressing the patch to adhere the film to the wall, and painting the patch and wall. (Col 3, lines 38-45, Col 4, lines 2-11, and Col 5, lines 19-36) Swanson is silent as to the "stain" includes ink, crayon, lipstick, grease pencil, colored marker, smoke, water, tannin, hydrophilic stain,

lipophilic stain, food residue, a dye, conjugated organic compound, an aromatic color body, a wood knot, mineral oil, petrolatum, or wax wherein the dry film layer prevent migration of the stain to the coating layers and prevent the coating layer from dissolving the stain. However, blocking stain with a dry film is well known and conventional as shown for example by Shih et al. Shih et al discloses a method of blocking stain with a barrier layer, which is a dry film. The method includes applying the film to the stain, which includes coated nail, ink marker, adhesive, pens, wood extractives, asphalt, driveway sealer, primers, shoe polish, or dyes onto a surface such as a floor or wall to prevent stain from diffusing to through the surface covering and would prevent liquid coatings from dissolving the stain. (Col 1, lines 21-26 and Col 2, line 64 to Col 3, line 7)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to block a stain with a dry film as disclosed by Shih et al in the method of Swanson to provide a stain blocking barrier to prevent the diffusion of stains onto the surface covering, which prevent any undesired visual to the consumer. (See Shih et al, Col 1, lines 16-20 and Col 1, lines 29-33)

Regarding claim 70, Swanson discloses the patch includes a feathered edge. (Col 3, line 66 to Col 4, line 11)

4. Claims 2, 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson (U.S. 6,607,621) in view of Shih et al (U.S. 5,891,294) as applied to claim 1 above, and further in view of Reed et al (U.S. 3,432,376).

Regarding claim 2, Swanson as disclosed above is silent as to the dry film is supported on a release layer and the pressure applied to the dry film layer is provided

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through the release layer. However, providing a dry film is supported on a release layer and the pressure applied to the dry film layer is provided through the release layer is well known and conventional as show for example by Reed et al. Reed et al discloses a method of dry transferring a dry film from a carrier sheet. The method includes providing thin transferable film carried by a carrier sheet, an adhesive layer on the thin transferable sheet, and a protective covering sheet on the adhesive layer, removing the protective sheet from the adhesive layer, applying the adhesive surface to the receiving surface, applying pressure through the carrier sheet, and pull away the carrier sheet, which is also used as a mask. (Col 2, lines 9-14 and Col 9, lines 3-10)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a dry transfer sheet as the dry film as disclosed by Reed et al in the method of Swanson as modified by Shih et al to enable a user to transfer and cover the desired surface area with a dry film of any size and shape at the will of the user. (See Reed et al, Col 1, lines 23-28)

Regarding claims 47-50, Swanson as disclosed above is silent as to the pressure is applied by hand, roller, spatula, or blade applicator uniformly across the surface of the dry film layer. However, applying pressure by hand, roller, spatula, or blade applicator uniformly across the surface of the dry film layer is well known and conventional as shown for example by Reed et al. Reed et al discloses the pressure is applied by needle stylus or knife or scribing tool or a ballpoint pen or radiused rod of metal wood or plastic, which is considered to be a roller and operated by hand. (Col 2, lines 25-45)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide needle stylus or knife or scribing tool or a ballpoint pen or radiused rod of metal wood or plastic, which is considered to be a roller and operated by hand as disclosed by Reed et al in the method of Swanson as modified by Shih et al to enable a user to transfer and cover the desired surface area with a dry film of any size and shape at the will of the user. (See Reed et al, Col 1, lines 23-28)

***Response to Arguments***

5. Applicant's arguments with respect to claims 1 and 69 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's arguments filed May 23, 2005 have been fully considered but they are not persuasive.

7. Applicant's argument of Reed does not mention covering holes or cracks in a wall. The examiner relied on Reed to provide the teaching of supporting a dry film for covering a surface on a release film and to apply the film by press on the release film.

8. Applicant's argument of Shih does not mention covering holes or cracks in a wall. However, Shih et al does teach the barrier layer is a part of a surface covering and includes wall and ceiling covering. (Col 2, line 64 to Col 3, line 8) The patch of Swanson is a wall covering. The combination of Swanson and Shih discloses the instant invention.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Shih provided the motivation to combine, i.e. providing a stain blocking barrier layer to be incorporated into surface covering products to prevent diffusion of stains onto the through the surface covering from a surface or object located directly on or beneath the lower surface. (See Shih, Col 1, lines 29-33)

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
SPC

  
CURTIS MAYES  
PRIMARY EXAMINER